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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/752,263	12/28/2000	David S. Bormann	42390.P9734	1227

7590

04/13/2004

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EXAMINER
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DU, THUAN N

ART UNIT	PAPER NUMBER
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2116

DATE MAILED: 04/13/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

PRG

<b>Office Action Summary</b>	<b>Application</b> 09/752,263	<b>Applicant(s)</b> BORMANN ET AL.	
	<b>Examiner</b> Thuan N. Du	<b>Art Unit</b> 2116	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-7 and 9-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7 and 9-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. It is hereby acknowledged that the following papers have been received and placed of record in the file: Amendment A and Terminal Disclaimer (dated 1/27/04).
2. Claims 3 and 8 have been cancelled. Claims 1, 2, 4-7 and 9-15 are presented for examination.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 112***

4. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claim 2 recites the limitation "the ACPI S state" in line 1. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

6. Claims 1, 2, 4-7 and 9-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nyudou (U.S. Patent No. 6,496,507).
7. Regarding claims 1 and 4, Nyudou teaches a method comprising:  
  
determining a first system Advanced Configuration and Power Interface Specification (ACPI) state, the ACPI states including a first power on state (operating state) and a second

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power state (standby state), the second power state to consume less power than the first power state [Fig. 5; col. 10, lines 25-33]; and

switching between two devices, the switching based upon the ACPI state [Fig. 5; col. 8, lines 23-39; col. 10, lines 23-33].

Nyudou does not explicitly teach the devices having an off state. However, one of ordinary skill in the art would have recognized that any system would have a power off state. Furthermore, Nyudou's teaching would be applicable when one device is at power on state and the other is at power off state.

Also, Nyudou does not explicitly teach the switching method is used in ATA environment. One of ordinary skill in the art would have readily recognized that the teaching of Nyudou could obviously be applicable to any environment.

8. Regarding claim 2, Nyudou teaches that the ACPI S states are S0 (on) and S1, S2, S3 or S4 (standby).

9. Regarding claims 5 and 6, Nyudou teaches that switching to the first system if the ACPI state is S0 (on) [col. 10, lines 25-33], and switching to the subsystem if the ACPI state is S3 or S4 (standby) [col. 10, lines 25-33].

10. Regarding claim 7, Nyudou teaches the claimed method steps. Therefore, Nyudou teaches the instructions for carrying out the claimed method steps.

11. Regarding claims 9-15, Nyudou teaches the claimed method steps. Therefore, Nyudou teaches the apparatus to implement the claimed method steps.

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***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuan N. Du whose telephone number is (703) 308-6292. The examiner can normally be reached on Monday-Friday: 9:00 AM - 5:30 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas C. Lee can be reached on (703) 305-9717.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

The fax number for the organization is (703) 872-9306.



Thuan N. Du  
April 8, 2004